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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,766	08/22/2001	Toru Ozaki	826.1742	6192

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,766

Applicant(s)

OZAKI ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 11-3-05 amended the specification and claims 1, 6, 10 and 27 - 29 as well as traversed the Restriction Requirement.

Applicant's election with traverse of Restriction Requirement in the reply filed on 11-3-05 is acknowledged. The traversal is on the ground(s) that there is no basis for the Restriction since the claims were all searched previously. This is not found persuasive because the newly amended claims have resulted in a new interpretation, which as indicated in the Restriction requirement is based on the outsource center. The Applicant's arguments with respect to claims 1 – 9 are persuasive

Claims 10 – 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11-3-05.

The requirement is still deemed proper and is therefore made FINAL.

Currently, claims 1- 9, 28 and 29 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, the word "parallel" is a relative word, which renders the claim indefinite. The word "parallel" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the word "parallel" will be treated as to correspond to a television program with merged commercials.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Gerszberg (US 6,178,446 B1).

Regarding claim 1 and related claims 28 and 29 (CURRENTLY AMENDED) A commerce information managing method for managing commerce information, comprising:

- receiving a request to generate a commercial message broadcast and commercial message information relating to the commercial message broadcast from at least one of a merchandise producer and a service provider;

- requesting for broadcasting, in parallel, both the commercial message broadcast and the commercial message information relating to the commercial message broadcast generated according to the commerce information; and

- receiving, as part of the commerce information, commercial message broadcast designation information contained in the commercial message information and designating at least the commercial message broadcast when a client sees the commercial message broadcast, performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchases merchandise or a service in the commercial message information relating to the commercial message broadcast (see at least Abstract, Col 1, lines 59 – 67, Col 2, lines 1 – 7, Col 8, lines 16 – 20 and lines 44 – 46, Col 10, lines 13 – 36).

Regarding claim 2, Gerszberg teaches a method, wherein said commercial message information contains at least one of a merchandise catalog, a merchandise guide book in which merchandise is classified based on a characteristic of each piece of

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merchandise, a merchandise purchase support page supporting purchase of merchandise based on the merchandise guide book, a service catalog, a service guide book in which a service is classified based on a characteristic of each service, and a service purchase support page supporting purchase of a service based on the service guide book (Col 2, lines 36 – 39 and line 47 and Col 10, lines 2 - 3) and (claim 3) wherein: said CM information is described in an XML data format; and specific information contained in the CM information is distributed (Col 2, line 47 and Col 5, lines 39 - 43). Please note that Gerszberg does not disclose XML. However, Gerszberg does disclose receiving additional information such as purchase order over the service configured to support IP. In this regard, it would have been obvious to one of ordinary skill in the art to have extended the method and system of Gerszberg with XML, which will provide the necessary information regardless of file structures.

Regarding claim 7, Gerszberg teaches a method, wherein said commerce information contains any of information relating to merchandise or a service, attribute data of the client, and information about merchandise or a service purchased by the client (Col 2, line 42 – 49 and Col 10, lines 13 - 36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 - 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (US 6,178,446 B1) in view of Mayer (US 5,774,534).

Gerszberg substantially discloses and teaches the applicant's invention.

However, Gerszberg does not specifically disclose and teach a method wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station and wherein said broadcast program is changed based on at least one of merchandise inventory information about the merchandise producer and service providing information about the service provider and further comprising: analyzing data of the managed commerce information; and transmitting an analysis result to the merchandise producer or the service provider.

On the other hand and regarding claim 4, Mayer teaches a method, wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is

bought from the broadcasting station (Abstract) and (5) wherein said broadcast program is changed based on at least one of merchandise inventory information about the merchandise producer and service providing information about the service provider.

Please note that Mayer does not specifically disclose changing broadcast information based on inventory or service is changed. However, it is old and well known that these would have been changed as warranted for prudent business and management principals. In this regard, it would have been obvious to one of ordinary skill in the art to change the broadcast program when inventory or service specifics changed. In this manner, it will ensure that current and potential customers are not surprised by a lack of inventory, which will adversely affect customer satisfaction. Thereby, the method will have ensured customer satisfaction.

Regarding claim 6, Mayer teaches a method further comprising: analyzing data of the commerce information being managed; and transmitting an analysis result to the merchandise producer or the service provider (Col 14, lines 15 – 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Gerszberg with the method and system of Mayer to have enabled a method wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station and wherein said broadcast program is changed based on at least one of merchandise

inventory information about the merchandise producer and service providing information about the service provider and further comprising: analyzing data of the managed commerce information; and transmitting an analysis result to the merchandise producer or the service provider. Gerszberg discloses a method as recited in claim 1 (see at least Abstract, Col 1, lines 62 – 67 and Col 2, lines 1 – 7 and Col 10, lines 13 - 36). In tern, Mayer discloses a method and system wherein commercial message is bought, inventory information changes the commercial message and analyzing data of the managed commerce information; and transmitting an analysis result to the merchandise producer or the service provider as well as wherein said CM broadcast designation information is transmitted through Internet or a communication line from a client home or a shop where a transmitting terminal is provided (see at least Abstract, Col 14, lines 15 - 42 and Figure 1). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Gerszberg with a method wherein a broadcast program for broadcasting the commercial message broadcast and the commercial message information relating to the commercial message broadcast is bought from the broadcasting station and wherein said broadcast program is changed based on at least one of merchandise inventory information about the merchandise producer and service providing information about the service provider and further comprising: analyzing data of the managed commerce information; and transmitting an analysis result to the merchandise producer or the service provider. In this manner, the broadcasting station is paid for services rendered, which is common in commerce transactions

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg (US 6,178,446 B1) in view of Esposito (US 6,587,838 B1).

Gerszberg substantially discloses and teaches the applicant's invention.

However, Gerszberg does not specifically disclose and teach a method, further comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service or further comprising assigning the client a service point based on the CM broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client.

On the other hand and regarding claim 8, Esposito teaches a method according, further comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service (Abstract and Figure 4).

Regarding claim 9, Esposito teaches a method, further comprising assigning the client a service point based on the commercial message broadcast designation information,

information about merchandise or a service purchased by the client, and attribute data of the client (Abstract and Figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Gerszberg with the method of Esposito to have enabled a method, further comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service and further comprising assigning the client a service point based on the commercial message broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client and transmitting information about the service purchased by the client as well as placing an order - in order to ensure that client receives appropriate follow on support from the best merchandiser. Gerszberg discloses a method as recited in claim 1. In turn, Esposito discloses a method and system further comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service and further comprising assigning the client a service point based on the commercial message broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client and transmitting information about the service purchased by the client as well as placing

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an order (Abstract and Col 2, lines 11 – 16 and Figure 4). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Gerszberg with a method and system further comprising distributing instructions about merchandise or a service generated by the merchandise producer or the service provider to a shop at which a client receives merchandise or a service so that the client can receive a support of aftercare for the merchandise or the service and further comprising assigning the client a service point based on the commercial message broadcast designation information, information about merchandise or a service purchased by the client, and attribute data of the client and transmitting information about the service purchased by the client as well as placing an order. In this manner, the client is provided with a merchant convenient to them and thereby easing their requirements to find one. This ease of use will increase their satisfaction, which will increase the probability that the client will recommend the method to others.

Response to Arguments

Applicant's arguments filed 11-3-05 have been fully considered but they are not persuasive.

Applicant argues that Gerszberg would not have suggested a commercial message broadcast with request, which allows for the immediate processing - without requiring knowledge of when the commercial message is broadcast.

In response, the claims as recited do not preclude nor include claim language "without requiring knowledge of when the commercial message is broadcast".

Applicant argues that there was not a motivation to combine Gerszberg with the other references based on the amended claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Please see above.

Applicant argues that the Examiners use of "old and well known" is not considered admitted prior art.

The response provided by the Applicant is not considered a challenge to the "old and well known" statement nor is timely.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is "IMON.COMTV FUSES NET, TV"; Marshal Rosenthal; Electronic Media; 3/27/2000 and Wolfe (US 6,161,142), which disclose a merged TV and advertisement as well purchasing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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